

**REMARKS:****Summary of Amendments to the Claims**

Applicants have amended claims 9-13 and added claims 14-29 to more particularly define the present invention. Claims 9-29 are in the application.

**Priority**

The Examiner asserts that the present application appears to claim subject matter disclosed in prior Application No. 08/275,025, filed on July 14, 1994, but does not claim priority to the prior application.

Applicants wish to bring the Examiner's attention to the preliminary amendment filed on November 23, 1999, wherein a cross-reference to the prior Application No. 08/275,025 was added to the specification. However, in the preliminary amendment, the filing date of the prior application was incorrectly indicated as July 6, 1994. The priority claim has been recognized by the USPTO as evidenced by the Filing Receipt issued on December 27, 1999 (copy attached) indicating the correct priority date July 14, 1994.

Applicants have corrected the filing date and updated the status of the prior application in the cross-reference thereto in the specification.

**Specification**

The Examiner continues to object to the amendment filed on February 7, 2000 under 35 U.S.C. 132 because it introduces new matter. The objected amendment is:

On page 3, lines 13-14 of the specification, the statement "by reacting iminostilbene with alkali cyanates in aqueous or alcoholic acetic acid mixtures" was amended to read "by reacting iminostilbene with alkali cyanates in aqueous or alcoholic or aqueous and alcoholic acetic acid mixtures."

Applicants have deleted the added matter from the specification as required by the Examiner.

**Claim Rejections-35 U.S.C. § 112**

Claims 9, 10, 12 and 13 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Claims 9-12 are further rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Applicants have amended claims 9-13. It is respectfully submitted that the amendments to the claims obviate the rejections under 35 U.S.C. § 112, first and second paragraphs.

#### **Claim Rejections-35 U.S.C. § 103**

The Examiner rejected claims 9 and 13 under 35 U.S.C. § 103(a) as being obvious over EP 277,095. The Examiner did not reject claims 10-12 based on the prior art. Therefore, applicants assume that the Examiner considers claims 10-12 as allowable over the cited prior art.

EP 277,095 teaches a process for the production of carbamazepine in which primarily cyanuric acid reacts with iminostilbene. Although an alkali salt of cyanuric acid can be used in an envisaged reaction, this salt has to be transformed to the acid through protonation with a strong acid prior to the reaction with iminostilbene. The disclosure of EP 277,095 directs a person skilled in the art to use strong acids together with the alkali metal salts of cyanuric acid in the reaction. It is unobvious from the disclosure of EP 277,095 to leave out the strong acid in the reaction because it provides no motivation for a skilled person in the art to do so.

In contrast, the present invention teaches for the first time that with the process of the claimed invention, the addition of such strong acids in connection with the aforementioned salts can be omitted without losing performance. Therefore, applicants respectfully submit that claim 9 and the depending claims are unobvious over the cited prior art.

New claim 14 corresponds to the subject matter of claim 10, which was not rejected by the Examiner over the prior art and is therefore assumed by applicants to be allowable over the prior art. Therefore, applicants respectfully submit that claim 14 and the depending claims are unobvious and patentable over the prior art.

The process of new claim 22 comprises the step of "reacting iminostilbene with an alkali cyanate in an alcoholic acetic acid mixture." Since EP 277,095 does not teach, or even teaches away

from, using alcohol in the reaction mixture, applicants respectfully submit that claim 22 and depending claims are unobvious and patentable over the prior art.

### Conclusion

Based on the foregoing amendments and remarks, favorable consideration and allowance of all of the claims now present in the application are respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be amended in formal respects in order to place the case in condition for allowance, then it is respectfully requested that such amendment be carried out by Examiner's Amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

The Commissioner is authorized to charge any required fees, including any extension and/or excess claim fees, or credit any overpayment, to Goodwin Procter LLP Deposit Account No. 06-0923.

Respectfully submitted for Applicants,



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